REMARKS

Applicant acknowledges with thanks the withdrawal of previous rejections under 35 U.S.C. §§ 101 and 112, first paragraph. Newly filed claim 23 has been withdrawn from consideration as being directed to a non-elected invention. Claims 1 – 10, 12 – 19, are pending in the application. All pending claims have been rejected.

Priority

On page 3 of the Office Action, the Examiner denied Applicant's claim for foreign priority based on PCT/FR98/02629 and an application filed in France on 4 December 1997 on the grounds that Applicant has not submitted certified copies of the PCT or the French application as required by 35 U.S.C. 119(b). Applicant hereby submits a certified copy of the French application. Withdrawal of the denial of foreign priority is therefore respectfully requested.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 1 – 10 and 12 – 19 are rejected under 35 U.S.C. § 112, second paragraph on the grounds that the claims lack specific and substantial utility. Applicant respectfully traverses. The Examiner's rejections are addressed below.

On page 5, paragraphs (a) and (b) of the Office Action, the Examiner stated that the use of the term "intact clone" or "intact target fragment" rendered the claim indefinite. Applicant argues that the one skilled in the art would understand the term "intact clone" to mean a nucleic acid fragment which retains its integrity or where the characteristic encoded by the nucleic acid fragment is not adversely affected by the restriction enzymes. However, to advance and expedite the prosecution of this application, Applicant has amended the claims to recite "a

target nucleic acid fragment having a known characteristic" instead of the "intact clone" language at issue.

In paragraph (c), the Examiner rejected claims 1 and 16 as indefinite because it was unclear whether the "fragment" referred to in step (b) of both claims referred to the "target nucleic acid fragment" of step (a) or the "further cleaved" fragments of "target nucleic acid fragment" in step (a). As the Applicant's current amendments clarify, the "fragments" referred to in step (b) of either claim refers not to the fragment of step (a); rather, the "fragments" of step (b) call for "a number of nucleic acid fragments of different characteristics, which are capable of containing one or more of said target nucleic acid fragments having a known characteristic." Put differently, the number of fragments called for in step (b) of claims 1 and 16 constitute a variety of different nucleic acid fragments which may contain the target fragment of step (a).

In paragraph (d), the Examiner pointed out that no monodigested libraries may be produced by subjecting the library to restriction enzymes to which the vector is insensitive as is called for in step (d) of claim 1. Applicant has amended claim 1 to remove the limitation. Similar amendments were made to step (e) of claim 16, step (b) of claim 18, and step (b) of claim 19. Applicant therefore submits that the Examiner's rejections detailed in paragraphs (d), (h), (k), and (m) have been overcome. Withdrawal of the indefiniteness rejection is respectfully requested.

On page 6, paragraph (e), the Examiner found the correlation between steps (d) and (e) in claim 1 to be unclear. Applicant submits that, with the removal of the limitation in step (d), the correlation between steps (d) and (e) should be clarified. Similarly, the correlation between steps (e) and (g) of claim 16, questioned in paragraph (i), should become clear with the similar amendment to claim 16 made above. Applicant therefore submits that the Examiner's

rejections detailed in paragraphs (e) and (i) have been overcome. Withdrawal of the indefiniteness rejection is respectfully requested.

In paragraph (f) addressing claim 1, paragraph (j) addressing claim 16, and paragraph (l) addressing claim 18, the Examiner's rejections questioned whether subjecting the library to restriction enzymes to which the target fragment is insensitive would result in multidigested libraries. Applicant respectfully disagrees. In these claims, the step in question discloses the use of a multitude of restriction enzymes to which some of the nucleic acids in the library are sensitive, but which do not affect the integrity of the target nucleic acid fragment. In other words, the restriction enzymes used will cleave all the fragments constituting the library with the exception of the target nucleic acid fragment. *See* page 13 of the specification. The resulting multidigested library will contain the target nucleic acid fragment. Applicant asserts that the current amendments in claims 1, 16 and 18 have clearly pointed out this step of the invention. The indefiniteness rejection should thus be withdrawn.
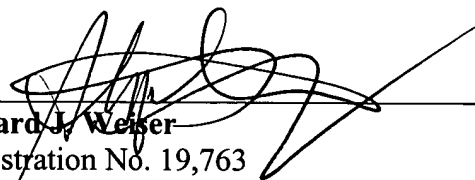
In paragraph (g), the Examiner rejected claim 1 as indefinite since it was unclear whether the "initial library" of step (c) is the same initial library that is used both for step (d) and (f). Applicant, by the foregoing amendment, has clarified this issue by designation of a first initial library and a second initial library, the latter of which is a reproduction of the first initial library.

The Examiner further rejects claims 16 – 18 for failure to include an isolation step. By the foregoing amendments, Applicant has added an isolation to the claims. Applicant asserts that the claims, including dependent claim 17, now include all necessary steps. Withdrawal of the indefiniteness rejection is therefore respectfully requested.

CONCLUSION

In so far as the above amendments and remarks have addressed fully the Examiner's rejections, the instant application is seen to be in condition for allowance. In view of the foregoing, withdrawal of the Examiner's rejections and issuance of a Notice of Allowance of all pending claims is therefore respectfully requested.

Respectfully submitted,
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